

The Examiner asserts the existence of two inventions: Invention I, with claims 1-3, 15, and 16 "drawn to an apparatus and method for inducing hypothermia inducing a device inserted into the oral cavity"; and Invention II, with claims 6-14, "drawn to an apparatus and method for inducing hypothermia including a device inserted into the oral cavity and a device positioned around the neck."

Pursuant to 37 C.F.R. § 1.176, relating to examination of reissue, Applicant can only elect previously unclaimed subject matter by disclaiming all the patent claims in the original patent. Pursuant to MPEP § 1450, the appropriate procedure is to issue an Office Action (1) providing notification of the restriction requirement, (2) holding added claims to be constructively non-elected and withdrawn, and (3) treating the original patent claims on the merits. Given the peculiar procedural posture of this case, the original Office Action treated Group I on the merits, but declined to consider Group II on issues relating to 35 U.S. C. § 251. MPEP § 1450 provides that once notification of the restriction requirement and claims are treated on the merits, "it is too late to obtain an examination on the added claims in the reissue application by filing a disclaimer of all the original patent claims." Accordingly, Applicant believes that pursuant to 37 CFR § 1.176, the claims of Group I have been constructively elected as a matter of law.


The election (whether actual or constructive) is subject to the right of Applicant to file a divisional reissue application pursuant to 37 CFR § 1.177 and MPEP § 1451.

Should the Examiner have any comments, questions or suggestions relating to a speedy disposition of the application, the Examiner is invited to call the undersigned at (505) 998-1500.

Consideration and allowance of the application are respectfully requested.

Respectfully submitted,

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